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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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28875	7590	11/12/2009		
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			EXAMINER	
			MILEF, ELDA G	
			ART UNIT	PAPER NUMBER
			3694	
			NOTIFICATION DATE	DELIVERY MODE
			11/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/879,683

Applicant(s)

SCHWEITZER, LIMOR

Examiner

Elda Milef

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 8-13, 15, 20-28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 8-13, 15, 20-28 and 30-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-884)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner found support for identifying an account using a portion of the IP address and port numbers on pages 7 and 9 of the specification, however, support could not be found for the account is identified using the at least a portion of the IP address and the credit card information

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 8-11, 13, 20-23, 25-28, 30, 31, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen (U.S. Patent No. 5,905,736) in view of Egendorf (U.S. Patent No. 5,794,221) in further view of Foster (U.S. Patent No. 6,332,134) in further view of O'Neil (US 2002/0069165).

Re claims 1, 13, 25: Ronen disclose a method, computer program product, and system comprising:

receiving information utilizing a network, wherein the information includes an Internet Protocol (IP) address of a user and an amount of payment due ("the ISP transmits to the billing platform the IP address identity of the user making the transaction and the cost associated with the transaction")-see col. 2 lines 13-16;

identifying an account using at least a portion of the IP address; and administering payment for the payment due by billing against the account; wherein the receiving, the

identifying, and administering are carried out by a network service provider;. ("The billing server then cross-references the IP address associated with the cost...with the IP address/transaction received from the ISP to properly charge an established account of the user for the transaction...")-see col. 2 lines 16-30, cols. 3-4 and ("In parallel with the ISP providing service to the user..., the ISP signals the transaction server to bill the account associated with the IP address to which the ISP is providing service... the transaction server bills that account...")-see col. 7 lines 61-67 and ("IAP" Internet access provider) cols. 2-9, and Abstract.;

wherein user data is identified based on the received information, and the user data is sent to a site ("Before completing the transaction, therefore, the accessed ISP, such as ISP 106, communicates with the transaction server 109 to determine whether that IP address has an established billing entry to which charges for the transaction can be forwarded and recorded. Such communication can take place over a dedicated private link 117 between ISP 106 and transaction server109, or over a secured Internet link...If such an entry exists on database 110, ISP 106 is signaled over the secured link, to authorize the transaction...")-see col. 5 lines 52-67; cols. 2, 5, 6;

wherein the site sends the information in response to the user carrying out a transaction using the site ("In response to a chargeable transaction with an ISP, the ISP transmits to the billing platform the IP address of the user making the transaction and the charge for the transaction")-see Abstract, col. 2 lines 5-30;

wherein a uniform resource locator (URL) link is provided to the user from the site, where the URL allows the user to give permission for the payment to be

administered ("If no billing mechanism has been established, then at step 218 (in FIG. 4), the ISP sends the user a URL to an HTML page for selecting a billing mechanism...the billing mechanism will include the user's desired method or methods of billing, and any parameters that define when a particular billing method is to be applied.")-see col. 7 lines 34-40, FIGS. 2-4,

and, in response to the user giving the permission, the site receives confirmation ("At decision step 214, if the presence of a billing mechanism is confirmed, at step 223, the ISP receives confirmation from the transaction server and provides the requested service to the user, the latter including delivery of the requested information, the downloading of requested software, or a confirmation of an order...")-see col. 4 lines 52-67.

wherein the network service provider maintains the account for the user, the account including the user data for allowing the user data to be identified based on the received information- see col. 5, lines 18-44, col. 8 lines 10-22;

Although Ronen discloses a confirmation received from the transaction server, Ronen and Egendorf do not specifically disclose that the site is provided with a confirmation number and shipping information of the user and the user is provided with the confirmation number. Foster however, teaches a financial transaction system conducted using the Internet which discloses ("The message to the cardholder, shown at path 216 may be an order confirmation number or indication that the order is to be placed. The message to the merchant includes a unique order number and a pre-registered shipping address or an authorized alternate shipping address, as shown at

path 218...")-see col. 8 lines 42-63 and cols. 7-8. Foster do not disclose that the order confirmation number sent to the cardholder and the merchant are the same. O'Neil discloses that the same confirmation number is displayed to the user and the merchant [0027]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen and Egendorf to specifically include that the merchant is provided with a unique order number and a shipping address of the user and that the cardholder is provided with an order confirmation number as taught by Foster and that the confirmation numbers provided to the cardholder and the merchant are the same as taught by O'Neil in order to allow the user and the merchant to easily identify the same transaction by confirmation number should a dispute arise.

Although Ronen disclose the purchasing of goods that will later be delivered by conventional transport means-see col. 1 lines 1-19, and ("These ISPs can also offer the user the ability to order tickets, or tangible goods from a retailer or Internet-order company associated with the ISP, or from a plurality of different such companies...")-see col. 3 lines 33-37, Ronen do not specifically disclose wherein the user data includes shipping information. Egendorf however, teaches an Internet billing method comprising the establishment of an agreement between an Internet access provider, customer, vendor and ("address supplied by the customer for shipment of the goods...")-see col. 4, lines 1-6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to specifically include that user data includes shipping information as taught by Egendorf in order for the vendor to ship products to the correct user destination. Furthermore, Ronen discloses the purchasing

of goods that will later be delivered by conventional transport means. It is obvious that in order for goods ordered online to be shipped to a consumer, the consumer must provide shipping information.

Re claims 8, 11, 20,23: Ronen disclose limiting the administration of payment based on a rule and wherein the account is a debit account-see col. 7 lines 37-40, Fig. 1 (120-3).

Re claims 9 and 10: Ronen do not specifically disclose collecting a fee from the site and the fee is a percentage of the payment due. Egendorf however, teaches ("The provider then bills the transaction amount to the customer and remits a portion of the transaction amount to the vendor, keeping the differential as a fee for providing the service")-see Abstract, and col. 4, lines 18-22. Official notice is taken that it is old and well known in the art of e-commerce that a fee is a percentage of payment due. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include charging a fee as a percentage of payment due as taught by Egendorf and is old and well known, in order for the provider to generate income from the services provided to the vendor and consumer.

Re claims 21, 22: Further a computer program product would have been necessary to perform the method of previously rejected claims 9 and 10 and are therefore rejected using the same art and rationale.

Re claim 26: Ronen disclose: (a) providing a link to a site on a network where a business transaction is occurring; and (b) receiving information from the site at a third party location during the transaction wherein the information includes an Internet

Protocol (IP) address of a user and an amount of payment due –see cols 1-2. The remaining steps have similar limitations found in claims 1, 8, 9 above, and therefore are rejected by the same art and rationale.

Re claim 27: Ronen disclose wherein the information is received from a combination of the user and a site, where the information is received from the site in response to the user carrying out a transaction using the site.-see col. 2.

Re claim 28: Ronen disclose wherein the account is identified utilizing a database which links the information with a corresponding account. -see col. 2 lines 16-30, cols. 3-4.

Re claim 30: Ronen disclose wherein the rule identifies at least one category in which goods or services are permitted to be purchased.-see col. 4, in particular parameters of billing and the billing choice and Table 1.

Re claim 31: Ronen disclose the ISP sending the user a URL to an HTML page for selecting a billing mechanism col. 7 lines 34-37. Ronen disclose the transmission of user information to and from the Internet Access Provider connected to the consumer (101) and the merchants (ISP) (106, 107) in fig. 1 and related text. There are a finite number of ways to provide the user with a uniform resource locator (URL) link in order for a user to give permission for the payment to be administered. A person of ordinary skill has good reason to pursue the known option of presenting a URL link to one site which forwards the link to an end user. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time the invention was made, providing by the internet access provider to the merchant site, a URL link to be forwarded to the user

and incorporate this into the system of Ronen since there are a finite number of identified, predictable potential solutions (i.e., forwarding a URL link to the end user) to the recognized need (payment processing) and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success (providing the end user with an HTML page for authorization of payment).

Re claim 32: Ronen disclose receiving IP using a portion of the IP address to identify an account col. 2. Ronen do not disclose using credit card information for account identification. Egendorf however, teaches an Internet billing method including an agreement among a provider, vendor and customer. The customer pays for a purchase by specifying a type of account e.g., "VISA" to pay for a purchase. The system of Egendorf then associates "VISA" with a billing account of a customer. Col. 2 lines 9-41. The customer never provides the credit card number to the vendor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen to include using the credit card type e.g., "VISA" to cross reference a billing account of the customer as taught by Egendorf in order to maintain security of information because there is no need for the customer to transmit a credit card account number over the Internet.

5. Claims 12, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, Egendorf, and Foster, O'Neil in further view of Wilf et al. (hereinafter Wilf, U.S. Patent No. 5,899,980).

Re claim 12: Ronen, Egendorf, Foster and O'Neil do not specifically disclose wherein the steps are carried out by a financial institution offering credit with credit

cards in conjunction with a network service provider. Wilf however, teaches ("The STSP, the customers, the vendors and the ISPs receive financial services from one or more financial service providers...")-see col. 7 in particular, lines 26-33. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ronen, Egendorf, Foster, O'Neil to include a financial service provider offering services as taught by Wilf in order to provide the customer with convenient payment options.

Re claims 24: Further a computer program product would have been necessary to perform the method of previously rejected claims 12 and are therefore rejected using the same art and rationale.

6. Claims 3,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen, Egendorf, Foster, O'Neil in further view of Stewart (Stewart, John. *Connecting with Confidence*. Web Techniques. San Francisco: Apr 2000. Vol. 5, Iss. 4; pg. 84, 4 pgs.

Re claim 3: Although Ronen refers to identifying information relating to a customer such as an internet address -see col. 2, Ronen does not specifically disclose wherein the information further includes port numbers.

It is well known in the art as evidenced by Stewart, that port numbers are a way to identify a specific process to which an internet message is to be forwarded when it arrives at a server. ("The rules are simple: Control which machines (using IP addresses) can talk to one another on what services [using network port numbers].")-see p. 3, para.

2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include identifying a transaction by using a port number, as was taught by Stewart in order to control the transfer of information over the Internet.

Re claim 15: Further a computer program would have been necessary to perform the method of previously rejected claim 3 and is therefore rejected using the same art and rationale.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen in view of Egendorf in further view of Foster in further view of O'Neil as applied to claim 1 and further in view of Cheong et al. (US 7,006,993).

Re claim 33: Ronen disclose parameters of billing and billing choice col. 4 lines 40-60. Ronen, Egendorf, Foster, and O'Neil do not explicitly disclose a hierarchy of purchasable item categories allowing users to pre-select purchasable categories which limit items allowed to be purchased. Cheong however, disclose an e-commerce web-site with pre-specified merchandise groupings; type-specific shopping pages; rank-ordered type-specific lists. col. 18 lines 6-39 Figs. 24-26. It would have been obvious to one having ordinary skill in the art to include in the Internet billing methods of Ronen, Egendorf, Foster, and O'Neil the ability to include pre-specified merchandise groupings as taught by Cheong since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ronen in view of Egendorf in further view of Foster in further view of O'Neil as applied to claim 1 and further in view of Sendo et al. (US 6,970,852).

Re claim 34: Ronen Egendorf, Foster, and O'Neil do not disclose the URL link links to another site that is internal to the network service provider. Sendo however, teach restricting purchases to those merchants associated with the provider of a private network .

It would have been obvious to one having ordinary skill in the art to include in the Internet billing methods of Ronen, Egendorf, Foster, and O'Neil the ability to include restricting purchases to those merchants associated with the provider of a private network as taught by Sendo since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

9. Applicant's arguments filed 10/27/2009 have been fully considered but they are not persuasive.

Regarding the argument that the O'Neil reference is improper because the applicant's priority date is prior to the reference date, the written description requirement issue generally involves the question of whether the subject matter of a claim is supported by [conforms to] the disclosure of an application as filed. If the examiner concludes that the claimed subject matter is not supported [described] in an application

as filed, this would result in a rejection of the claim on the ground of a lack of written description under 35 U.S.C. 112, first paragraph or denial of the benefit of the filing date of a previously filed application. -MPEP 2163.01. The rejection of the limitations in claims using the O'Neil reference is valid because the provisional application filed by the applicant on June 12, 2000 does not have support for the claim limitations rejected using the O'Neil reference.

Regarding the applicant's suggestion that Ronen, Egendorf, Foster and O'Neil do not disclose the newly added limitation "wherein the network service provider maintains the account for the user, the account including the user data for allowing the user to be identified based on the received information", Ronen disclose the IAP assigning the IP address to the user for use during the user's session col. 5 lines 14-25; once the session is terminated with the IAP, the IAP releases the IP address for use by another user and notifies the transaction server. Therefore, the IAP is maintaining the account for the user.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday -Friday 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571)272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elda Milef
Examiner
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/James P Trammell/
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